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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,008	08/03/2001	Laura C. Devaney	56850US002	8512

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Office of Intellectual Property Counsel  
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EXAMINER

CHANG, VICTOR S

ART UNIT PAPER NUMBER

1771

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/923,008

Applicant(s)

DEVANEY ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 7-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.                      6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to a pressure-sensitive adhesive cover tape, classified in class 428, subclass 343.
  - II. Claims 7-15, drawn to a carrier tape for electronic component transportation, classified in class 428, subclass 40.1.

The inventions are distinct, each from the other because:

2. Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as adhesive label and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Sandra Barnett on 11/5/2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains no structure describing the relation between the "layer of an electrically conductive coating" and the "layer comprising ... adhesive". It is not clear to the Examiner the order of these layers.

Claim 4, lines 2-3, the term "(poly-3,4-ethylenedioxy)thiophene" should be corrected as --poly(3,4-ethylenedioxy-thiophene)--.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (US 6027802) either individually, or in view of Abe et al. (US 6017610).

Lin's invention is directed to a cover tape for use with a carrier tape (column 1, lines 5-6). In Fig. 4, Lin teaches a cover tape comprising a substrate layer (12), selected from a group of biaxially extended polyester film, polypropylene film, etc., and a release coating layer (11). At an opposite side of the substrate layer (12), there are provided with an adhesive layer (13) and a non-adhesive layer (14) over the adhesive layer (13). The non-adhesive layer (14) has one side adhered to the adhesive layer (13), and an opposite side having a layer of antistatic coating (column 6, lines 4-25). Additionally, in Figs. 1-3, Lin shows various alternative structures of prior art cover

tapes. Lin also teaches that antistatic coating can be a coating of intrinsically conductive polymer, such as polyaniline (column 6, lines 29-35).

For claims 1, 3, 5 and 6, it is noted that Lin lacks the specific teachings of the composition of the conductive coating, the degree of clarity of the tape, and the surface resistance of the tape. However, it is believed that it is well known that polythiophene or polyaniline are suitable for making transparent conductive coatings. Alternatively, Abe's invention is directed to a conductive laminate made from polyester substrate (column 1, lines 12-14). Examples of conductive polymers include water dispersed polyaniline, polythiophene, and derivatives of these polymers such as sulfonated polyaniline (column 3, line 67 to column 4, line 7). Abe also discloses that the conductive laminate has a high transparency, and its surface resistance at 25°C, under 15% RH atmosphere is in the range of  $10^6$  -  $10^{12}$  Ohm (column 10, lines 25-34). It should be noted that the polymer backbones of polythiophene and polyaniline are inherently conjugated. Although Abe is silent about the clarity of the conductive coating, it is believed that since the scope of Abe's invention is essentially the same as the instant claimed invention, the degree of clarity of the tape laminate is either inherently disclosed or an obvious optimization. As such, it would have been obvious to one of ordinary skill in the art to modify the conductive coating of Lin's cover tape with Abe's conductive coating composition, motivated by the desire to make a cover tape which has good transparency and conductivity as taught by Abe.

For claim 2, In Fig. 4, Lin teaches a release coating layer (11) as set forth above.

For claim 4, it is believed that poly(3,4-ethylenedioxy-thiophene) is an obvious selection of a derivative of polythiophene polymer as taught by Abe (column 3, line 67 to column 4, line 7).

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making conductive polymer and cover tape:

US 5264552 to Abe et al.

US 5441809 to Akhter

EP 0898445 to Leonard Holley

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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November 12, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900-

1700

*Daniel Zinker*